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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,087	02/22/2000	Paul A. Smith	EVS-P-99-017	2705
7590	06/17/2004		EXAMINER	
				WALCZAK, DAVID J
		ART UNIT	PAPER NUMBER	
		3751		

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/510,087	SMITH, PAUL A.
	Examiner	Art Unit
	David J. Walczak	3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9, 11-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 12, 13 and 20 is/are withdrawn from consideration.
- 5) Claim(s) 9, 11, 14 and 21 is/are allowed.
- 6) Claim(s) 15-17 is/are rejected.
- 7) Claim(s) 19 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Martin et al. (hereinafter Martin). In regard to claims 15 and 16, Jones discloses a marking device accessory kit comprised of a marking device having a barrel with an exterior surface wherein the marking device has means (ink) for producing a mark within the barrel and a sheath 16 (see Figures 5- 6) defined between a first end and a second end which fits around the exterior surface of the marking device and forms a gap 15 between the ends thereby leaving a portion of the body not covered (the lower portion of Figure 6 shows such a gap which exposes a portion of the marker. Further, see column 5, lines 44-55). Although the Jones reference does not disclose an end cap which is interchangeable between different markers and a connecting chain, attention is directed to the Martin reference, which discloses another marker wherein an end cap 15 (which is interchangeable between different markers, see lines 82-85) and a chain 14 are connected to an end of the marker in order to enable the marker to be conveniently supported and stored when not in use. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such an end cap and chain to the Jones device in order

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to enable the Jones marker to be conveniently supported and stored when not in use. In regard to claim 17, the sheath includes an antimicrobial substance therein and the method as claimed is inherent in the usage of the device described supra. Although the sheath is formed by mixing plastic and the antimicrobial agent, and the sheath is not coated with the agent as claimed, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the sheath can either be molded with the agent or coated with the agent, without effecting the overall operation of the device, especially since the Applicant has indicated that the agent can be either contained in the material used to make the sheath, or applied to the surface of the sheath.

Allowable Subject Matter

Claims 9, 11,14 and 21 are allowed.

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 4/19/04 have been fully considered but they are not persuasive. The Applicant contends that the Jones reference is not applicable because Jones does not disclose a sheath in addition to a barrel. However, Figure 6 clearly shows a sheath 6 encircling a pen (see the brief description of Figures 5 and 6).

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Accordingly, Figure 6 shows both a sheath and a barrel (the body of the pen defining the barrel, which inherently includes "means for producing a mark" therein). In regard to the Applicant's contention that there is no suggestion to combine the Jones and Martin references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art, after reviewing both of these references (which both disclose marking instruments) would readily recognize that the Jones marking device as shown in Figure 6 can obviously be supported by the chain in the Martin device .

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
6/16/04